

REMARKS

This Amendment is responsive to the final Office Action¹ of May 16, 2008 and is the submission under an RCE. Claims 1-7 and 8-17 were presented for examination and were rejected. Claim 8 was previously canceled without prejudice or disclaimer. Independent claims 1, 9, 11, 16 and 17, are amended. Dependent claims 9 and 11 are amended. Claims 1-7 and 9-17 are pending. Claims 1, 9, 11, 16 and 17 are in independent form.

No new matter is added by way of this amendment. Support for the claim amendments can be found in the application, as filed. For example, see at least paragraphs [0008], [0032] and Fig. 3 including act 306.

Claims 11 and 13-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Burnstein et al. (U.S. 2002/0032735 A1; hereinafter "Burnstein"). Claims 1-7, 9, 10 and 17 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Burnstein in view of Munsil et al., U.S. Patent 5,761,650 (hereinafter, "Munsil") and further in view of Carter et al., (U.S. 2005/0068983 A1; hereinafter "Carter"). Claims 12 and 16 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Burnstein in view of Munsil. These rejections are respectfully traversed for at least the following reasons.

Claims 11 and 13-15:

Claims 11 and 13-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Burnstein. Claim 11 recites a method comprising *inter alia*: "*providing each of said*

¹ The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement.

plurality of customers with a customer profile questionnaire; receiving responses to said questionnaire from at least a portion of said plurality of customers; allowing a subset of said portion of said plurality of customers giving common answers to said questionnaire to have access to a domain associated with said service provider.” (italics added)

Burnstein does not teach or disclose these limitations. Burnstein does not inquire of its users or employees by way of a questionnaire or other device.

Instead, Burnstein discloses an automatic telephone, Internet or intranet community formation system that utilizes spoken words or matching search terms to invite persons to communicate. (Abstract) In particular, Burnstein teaches a system and method for automatically matching system users based upon search terms entered by those users into a searching process. The teaching compares a search with prior search terms entered by others to make a match between similar searches. After making a match, the matched parties are invited to join an electronic community. See Burnstein, at least paragraph [0013]. But, comparing searched subject matter to find common subject matter, and then matching users responsible for ordering searches of that common subject matter, as Burnstein does, has nothing to do with Applicant’s first providing questionnaires to users and then obtaining responses from them to those questions.

MPEP § 2131 states that to anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as

complete detail as is contained in the ...claim.” See *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989).

In this instance “providing each of said plurality of customers with a customer profile questionnaire; receiving responses to said questionnaire from at least a portion of said plurality of customers; allowing a subset of said portion of said plurality of customers giving common answers to said questionnaire to have access to a domain associated with said service provider” as recited in claim 11 is not disclosed or suggested by *Burnstein*, wherefore each and every element of claim 11 is not found in *Burnstein* and the identical invention is not shown in *Burnstein* in as complete detail as is contained in the claim. Therefore, the 35 U.S.C. § 102(e) rejection of claim 11 should be withdrawn and the claim allowed.

Claims 13-15, dependent from claim 11, are also allowable, at least for reasons given above with respect to claim 11.

Claims 1-7, 9, 10 and 17:

Claims 1-7, 9, 10 and 17 are rejected under 35 U.S.C. § 103(a) as being un-patentable over *Burnstein* in view of *Munsil* further in view of *Carter*. Claim 1, for example, recites a method comprising, *inter alia*: “*notifying said each of said plurality about said domain by including information in a billing statement for said each of said plurality; providing said each of said plurality with access to said domain; providing said each of said plurality with a customer profile questionnaire; receiving responses to said questionnaire from at least a portion of said plurality of customers.”* (italics/underlining added)

Per the Office Action, pg. 4, Burnstein fails to disclose a billing address, billing statement, etc. Applicant agrees. In addition, Burnstein does not disclose or suggest providing a customer profile questionnaire or responses to that questionnaire as recited in claim 1 for reasons given above with respect to claim 11.

The Office Action then refers to Munsil and alleges that Munsil discloses the tracking of customer billing information and account information, and provides customers with information, messages and notices, by including the information in a billing statement dedicated for the customer. (Office Action, pg. 4) Without acquiescing in the imposed Munsil-Burnstein combination, Applicant notes that any teaching in Munsil of providing customers with information, messages and notices is limited to Munsil directing such information to its customers, not eliciting information from its customers. Column 3, lines 17-24 and 57-61, cited in the Office Action (pg 4) to support its position, state as follows:

More particularly, the bill run portion of the system then qualifies each message, notice and insert against stored information about each customer. Only messages, notices and inserts relevant to a particular customer qualify for that customer. The qualifying messages and notices are stored in temporary memory. Then, all of the qualifying messages and notices are arranged according to priority, and only those that fit on the bill are eventually printed. (Munsil, col. 3, lines 17-24; emphasis added)

A service or product provider, such as cable television providers, local telephone service providers, long distance telephone providers, and credit card companies, store customer data on one or more databases within a customer management system. (Munsil, col. 3, lines 57-61)

These sections discuss first qualifying (i.e., comparing) each message, notice and insert against stored information about each customer, where the qualifying messages, notices and inserts relevant to that customer are then prioritized and put on the bill to the extent that they can fit on the bill. Qualified messages mean messages that are relevant for that customer. See Munsil, col. 12, lines 40-64 which discuss this subject. This

section also describes sending notice type information to the customer. It is clear that Munsil does not teach the forwarding of questionnaires to customers to elicit information from those customers for any purpose. At best, Munsil merely inserts notices or messages in, or on, a billing statement, to provide information to its customers. This is the opposite of Applicant's asking questions through questionnaires to obtain information from the customers.

Therefore, Burnstein, which is admittedly deficient vis-à-vis claim 1, and Munsil, which does not disclose or suggest supplying questionnaires to its customers or eliciting information from its customers, taken individually or in any reasonable combination do not disclose or suggest the subject matter of Applicant's claim 1. In addition, without acquiescing that Carter is properly combinable with Burnstein or Munsil, Applicant notes that Carter was cited merely to teach randomly-generated alias subject matter.

Accordingly, Carter does not cure the above-noted deficiencies of Burnstein or Munsil. Therefore, Burnstein, Munsil and Carter taken alone or in any reasonable combination do not disclose or suggest: "notifying said each of said plurality about said domain by including information in a billing statement for said each of said plurality; providing said each of said plurality with access to said domain; providing said each of said plurality with a customer profile questionnaire; receiving responses to said questionnaire from at least a portion of said plurality of customers" as recited in claim 1.

For the foregoing reasons the 35 U.S.C § 103(a) rejection of claim 1 should be withdrawn and the claim allowed.

Claims 2-7, dependent from claim 1 are also allowable, at least for reasons based on their respective dependencies from an allowable base claim.

Independent claim 9, which may be of different scope than that of claim 1, recites a system that includes the same limitations as, or similar limitations to, those discussed above with respect to claim 1 and is allowable, at least for reasons given above for allowability of claim 1.

Claim 10, dependent from claim 9, is allowable at least for reasons based on its dependency from an allowable base claim.

Independent claim 17, which may be of different scope than that of claim 1, recites a system that includes the same limitations as, or similar limitations to, those discussed above with respect to claim 1 and is allowable, at least for reasons given above for allowability of claim 1.

Claims 12 and 16:

Claims 12 and 16 are rejected under 35 U.S.C. § 103(a) as being un-patentable over *Burnstein* in view of *Munsil*.

Claim 12 is dependent from claim 11 and recites, inter alia, “notifying said plurality of customers about said domain by including information in a billing statement associated with said service provider.” *Burnstein*, admittedly, does not disclose or suggest a billing statement. Although *Munsil* does disclose a billing statement, it does not disclose the questionnaire limitations of claim 11 from which claim 12 depends. Therefore *Burnstein* in view of *Munsil* does not disclose or suggest subject matter of claim 12. For this reason the 35 U.S.C. § 103(a) rejection of claim 12 should be withdrawn and the claim allowed.


Independent claim 16, which may be of different scope from that of claim 1, is directed to a data display comprising a logon field, an alias field and a selection field. Applicant has amended claim 16 to recite, *inter alia*: “a selection field for allowing said customer to choose a topic of interest, said topic of interest being identified by said customer responding to questions in a customer profile questionnaire presented by said service provider to said customer on said data display and being linked to at least a subset of said persons sharing said common interest with said customer.” (emphasis added) For reasons that are the same as, or similar to, those given above with respect to claim 1, the cited references taken alone or in any reasonable combination do not disclose or suggest this limitation. For at least this reason the 35 U.S.C. § 103(a) rejection of claim 16 should be withdrawn and the claim allowed.

CONCLUSION

All rejections in the Office Action have been addressed. In view of the foregoing amendment and remarks, reconsideration and allowance of the pending claims are respectfully requested.²

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

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² Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.